

ATTORNEY DOCKET NO. 13529STUS01U (NORT10-00322)
U.S. SERIAL NO. 09/735,499
PATENT

REMARKS

Claims 1-19 are pending in the application.

Claims 1-19 have been rejected.

Claims 1, 5 and 14-19 have been amended, as set forth herein.

New dependent Claim 20 has been added.

I. REJECTION UNDER 35 U.S.C. § 102

Claims 1-7 and 12-14 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sylvan (US 5,943,055). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

With respect to independent Claim 1, the Office Action asserts that (1) Sylvan discloses a user interface for providing a list of new messages for which a notification has not been cleared, and (2) the list by Sylvan in Figure 1 describes the incoming messages that have just been received by the user thereby representing messages for which a notification has not been cleared. Office Action, page 2. Applicant respectfully submits that the Sylvan reference recites that the following list of

ATTORNEY DOCKET NO. 13529STUS01U (NORT10-00322)
U.S. SERIAL NO. 09/735,499
PATENT

stored information is presented to the user for each message: type of mail, name of sender, date and time of receipt, and originating telephone number. See Sylvan, Col. 6, lines 59-62. Absent from the list of stored information disclosed for each message is a notification status for messages. Furthermore, Sylvan presents its user with a list of all received mail messages, rather than a list of messages for which a notification has not been cleared. See Sylvan, Col. 4, lines 53-56.

In order to further prosecution in this case, Independent Claims 1 and 14 have been amended to recite (1) determining from the stored message status information which messages in said messaging system are new and for which a notification has not been cleared, and (2) presenting or providing to a user a list of message notifications associated with those messages determined to be new and for which a notification has not been cleared. Clearly, Sylvan does not disclose determining (from stored message status information) which messages are both new and for which a notification has not been cleared. Further, Sylvan does not disclose a user interface for providing a list of message notifications associated with the messages that were determined to be both new and for which a notification has not been cleared.

As such, Applicant respectfully submits that Sylvan fails to identically disclose each and every element/feature of Applicant's claimed invention, arranged as they are in independent Claims 1 and 14 (and dependent Claims). Accordingly, the Applicant respectfully requests withdrawal of the § 102(b) rejection of Claims 1-7 and 12-14.

ATTORNEY DOCKET NO. 13529STUS01U (NORT10-00322)
U.S. SERIAL NO. 09/735,499
PATENT

II. REJECTION UNDER 35 U.S.C. § 103

Claims 8-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sylvan (US 5,943,055) in view of Cahill, et al. (US 6,181,837 B1). Claims 15-19 were rejected under § 103(a) as being unpatentable over Sylvan (US 5,943,055) in view of Miller, "Background Polling". The rejections are respectfully traversed.

Claims 8-11 depend directly or indirectly from independent Claim 1. As described above, Sylvan fails to describe the elements/features recited in independent Claim 1. Moreover, Cahill relates to electronic check image storage and retrieval systems. Therefore, Applicant respectfully submits that none of the references, either alone or in combination, disclose, teach or suggest the Applicant's invention as recited in Claims 8-11.

Applicant has amended independent Claims 15 to recite, in general terms, (1) storing message status information for messages in said one or more messaging systems, whereby the message status information comprises a message notification variable for each message, and the variable comprises information for determining whether a notification has been cleared, and (2) providing to a user a list of message notifications associated with those messages that are new and for which a notification has not been cleared. Sylvan fails to disclose, teach or suggest storing a variable for each message that includes information for determining whether a notification has been cleared, or providing a list of message notifications for messages which are both new and for which a notification has not been cleared.

ATTORNEY DOCKET NO. 13529STUS01U (NORT10-00322)
U.S. SERIAL NO. 09/735,499
PATENT

Independent Claims 17, 18 and 19 have been modified to include amendments that are similar to the amendments made to independent Claims 1 and/or 14. For similar reasons as set forth above in response to the 102 rejection over Sylvan, Applicant respectfully submits that none of the references, either alone or in combination, disclose, teach or suggest the Applicant's invention as recited in Claims 17, 18 and 19, as amended.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 8-11 and 15-19.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

ATTORNEY DOCKET NO. 13529STUS01U (NORT10-00322)
U.S. SERIAL NO. 09/735,499
PATENT

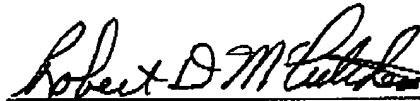
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 2/18/2004



Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: rmccutcheon@davismunck.com